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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,011	02/23/2004	R. Lee Miller	1140	7482

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EXAMINER	
BLAU, STEPHEN LUTHER	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/783,011	MILLER, R. LEE.	
	Examiner	Art Unit	
	Stephen L. Blau	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 18 October 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/783,011 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Canceling claims 9-16 are agreed with and the objection to the new matter under 35 U.S.C. 132(a) is removed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu and Takeuchi.

2001-46568 discloses a progressively and uniformly decreasing (Figs. 2-3, 5-6) external diameter (English Abstract) from a first diameter adjacent to a shaft end to a second diameter adjacent to a cap end (Figs. 2-3), a substantially circular cavity in the form of a circular shaft placed in grip ([0013] verbal translation, figures 2-3), and a grip having the same longitudinal axis as that of a shaft in the form of both being circular and having the same center line axis (Figs. 2-3).

2001-46568 lacks a grip having an external surface substantially circular cross-sectional configuration through out the length of a body, an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end, an alignment means being an elongated ridge in alignment with a longitudinal axis of a body, an integrally formed alignment means (ridge), an alignment means in alignment with the longitudinal axis of a shaft, and an alignment means in cooperation with a decreasing diameter of a grip body.

Miyasu (Figs. 1, 4, Abstract, [0015]) discloses an alignment means (ridge) extending upwardly from an exterior surface of a body from a shaft end to a cap end (Fig. 2), an alignment means being an elongated ridge in alignment with a longitudinal axis of a body in the form of the rail being straight on a tapered grip body, an alignment means in cooperation with a decreasing diameter of a grip body (Fig. 1), an external surface being circular (Fig. 4) and a prior art grip having an alignment ridge in the form of a line of protrusion integrally formed [0004]. Miyasu does not disclose the external surface being circular throughout the length of a shaft but clearly an artisan designing a grip with a uniform feel would have selected a suitable shape throughout the length in

which circular is included. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have an alignment means (ridge) extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body, and an alignment means in cooperation with a decreasing diameter of a grip body in order to assist a golfer in properly aligning a club at impact. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have a grip having an external surface substantially circular cross-sectional configuration through out the length of a body in order to provide a uniform feel along the length of a shaft by having the shape stay the same. As such the alignment means would be in alignment with the longitudinal axis of a shaft.

Takeuchi discloses an integrally formed alignment ridge on an exterior surface with a substantially circular cavity on the inner surface (Fig. 2). In view of the patent of Takeuchi and the prior art disclosed by Miyasu it would have been obvious to modify the grip of 2001-46568 to have an integrally formed alignment means on an exterior surface in order to simplify the assembly process of placing a grip on a shaft by not having to force a noncircular inner surface of a grip around a shaft with a circular outer surface.

5. Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu and Takeuchi as applied to claims 1, 4-6 and 8 above, and further in view of Hadge.

2001-46568 lacks a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. Hadge discloses a reversed tapered grip having a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch (Col. 3, Lns. 54-59). In view of the patent of Hadge it would have been obvious to modify the grip of 2001-46568 to have a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. in order to utilize dimensions for reverse tapered grips used in the market place.

Response to Arguments

6. The argument that it is improper to use the reference of Miyasu with 2001-46568 since Miyasu consistently refers to conventional or regular grips and there is not mention to reverse taper grips is disagreed with. Every grip is in need to be aligned no matter what the external shape of the outer surface. An alignment rail allows a golfer to feel the rail and as such have a feel for the alignment. The argument that it is improper to use the reference of Miyasu with 2001-46568 since Miyasu is designed to prevent hands from slipping away and provide comfort to hands is disagreed with. A rail provides an obstruction to rotation which is important for reverse taper grips as well. Never-the-less Miyasu also has a rail for alignment reasons which would be motivation as well for a reverse taper grip. A reverse taper grip is in need for alignment means as well as a conventional grip. The argument that it is improper to use the reference of Miyasu with 2001-46568 since Miyasu could have selected a reverse taper grip but

either ignored or overlooked it is disagreed with. There are many obvious modifications one skilled to the art brings to devices. To say that if one cannot find a 35 U.S.C. 102 reference to apply to claims than it must be allowable defeats the intent of 35 U.S.C. 103. The examiner believes that Miyau provides motivation to one skilled in the art to apply rails to other grips including reverse tapered grips which is to help a golfer align a grip. The examiner has considered the arguments of 15 October 2006 and believe the above comments cover these arguments as well. The two declarations with the comments by satisfied customers as well as the test data by golf companies both dated 18 October 2005 have been considered but are not persuasive. The examiner would expect for any group of people that by adding an alignment ridge to a grip the accuracy of the golfer would increase due to aid of the alignment device. In addition, many of these comments appear to be the same advantages as stated by the reference 2001-46568 which are to improve holding power, suppress slippage and stabilize the swing (English Abstract). The declaration with the financial reports dated 18 October 2005 to prove commercial success have been considered but is not persuasive. The examiner does not believe there is enough information to determine that there is a nexus between the claimed invention and evidence of commercial success. First in the "Sales by Item Summary" report it is uncertain what grip has the claimed invention. Is it all of the "Full Release" grips which contain all of the claimed structure of claims 1 or 6? It seems that the RCG60 might not since it is a wrapped grip. Does the RCG60 have both the reverse taper and the alignment means (ridge) as claimed? Are the X Wrap Grip, XL-Full Cord Grip, X Line Grip, Designer Grip, X Wrap Grip, X Line Grip, and XI Full Cord

Grip other grips that Feel Golf Company makes? Do any of these grips have a reverse taper or an alignment means (ridge)? What were the sales over the previous 19 months (before March 1, 2004) and were there any reverse taper and/or alignment means grips sold during the 19 months before March 1, 2004 ? How much was used for marketing for the 19 months from March 1, 2004 thru March 31, 2006 and for the previous 19 months? This is important to prove that the increased sales were not the result of heavy promotion or advertising, or a shift in advertising (Article 716.03, MPEP). What was the market share for the company before the claimed grip begin to sale? This information helps show that the purchase of the claimed grips were not purchase normally tied to the applicant or assignee. Did the company have a grip with part of what was claimed where there was not commercial success but when the completely claimed grip was made sales took off? The examiner believes that there might be an argument for commercial success but more information needs to be supplied. The needed information to determine if there is a nexus between the claimed invention and evidence of commercial success is discussed in article 716.03 of the MPEP. The examiner recommends reading this article and providing the answers to the questions above if possible.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

19 June 2006

STEPHEN BLAU
PRIMARY EXAMINER